

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Jonathan Stinson
Application No.:	10/037036
Filed:	October 25, 2001
For:	Balloon Expandable Polymer Stent With Reduced Elastic Recoil
Examiner:	Vi X Nguyen
Group Art Unit:	3734

Mail Stop Petition,  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Docket No.: S63.2B-9919-US01

**37 CFR 1.181 Petition to the Director**

This petition is being filed with an Appeal Brief, the third appeal taken in this case. This petition, as a main request, asks that the Director exercise supervisory authority in this case to require that in response to the filing of the accompanying Appeal Brief, the Examiner be instructed to either file an Examiner's Answer or to allow the application.

As a supplemental request the Director is requested to revise procedures to assure that reopening of prosecution after appeal once again becomes rare.

This petition is accompanied by the fee required under 37 CFR 1.17(f).

**Facts**

This case has been pending nearly 7 years. It was filed in October 2001. In that time the applicant has not filed an RCE. Appeal Briefs have been filed twice previously. Each time prosecution was reopened without an Examiner's Answer. In between the two previous appeals an indication of allowability was obtained, but that indication was subsequently

withdrawn and prosecution reopened, after applicants had made amendments to conform the then pending claims to the subject matter indicated to be allowable. The Office Action of June 30, 2008 therefore is the *third* un-consented reopening of prosecution in this case. In none of the reopenings has there been an articulation why any new rejections were not made previously nor why the rejection is not cumulative of issues previously dealt with.

In the most recent action (6/30/2008) the Examiner has imposed an anticipation rejection that is substantively indistinguishable from the rejection withdrawn three years ago when the Examiner reopened prosecution after the First Appeal Brief (the rejection is based on a divisional of the earlier cited document). The Examiner had a full and fair opportunity to justify the rejection to the Board at the time the First Appeal was taken and chose not to do so. The Examiner has indicated no "new light" that would justify the reintroduction of this rejection and has not provided any reason why the issue has been reintroduced into this case three years after it had been conceded.

The 6/30/2008 Office Action also imposes an obviousness rejection on a technically new combination, but the new secondary document is facially insubstantial and does not address the deficiencies raised in the Second Appeal Brief against the previously outstanding obviousness combination.

The Third Appeal Brief filed with this petition addresses the substantive merits of both rejections in the 6/30/2008 Office Action.

**Argument**

**Main Request**

The Kafkaesque circular examination to which this application has been subjected is arbitrary and capricious in violation of the Administrative Procedure Act, 5 USC §706, and violates Constitutional Due Process.

Applicant's have a statutory right to Appeal after a second rejection. 35 USC §134(a). The Office has no authority to attempt to circumvent this right. The statute is designed to facilitate expeditious and examination at reasonable cost, and ultimately to provide applicant's with a mechanism to bring their case to a point where judicial review becomes available. Reopening of prosecution after filing an Appeal Brief, as a conventional step in the examination process, frustrates applicant's statutory right and is facially improper.

This has been an exceedingly excessive prosecution. It needs to stop. Withdrawing a rejection that is taken on appeal and then re-imposing it three years later, substantially interfered with the applicant's statutory right of review under 35 USC §134 (a) without any good cause. Doing so when withdrawing a second appeal was particularly abusive, and was made even more so when the other rejection imposed is insubstantially different from the subject matter of the Second Appeal.

The Examiner has had enough time to articulate his position on patentability. The Director is requested to instruct the Examiner to file an Examiner's Answer if he continues to assert unpatentability after reviewing the Third Appeal Brief. If the Examiner does not file an Answer the case should be allowed.

**Supplemental Request**

The Office has publicly stated that reopened prosecution after an appeal is filed should be "rare." This has not proven to be true. Between the January 1, 2008 and the drafting of this petition in mid-August 2008, the undersigned's office of 12 attorneys had received Office Actions in 21 different applications where an appeal brief had been previously filed. Thus reopened prosecution is a common, perhaps even usual, response to a first Appeal Brief. Moreover, as has happened in this case, reopened prosecution is frequently occurring multiple times in a single application. The practice of un-consented reopening of prosecution has become abusive.

The requirement in MPEP 1207.04 for SPE approval to reopen prosecution after an appeal brief is totally ineffective in protecting applicant's rights under 35 USC §134(a). No standard for deciding approval is required in MPEP 1207.04. SPE approval is being arbitrarily granted without any basis articulated on the record. This is arbitrary and capricious. The Office has effectively institutionalized a circular examination system that effectively precludes review of Examiner actions. It withholds or unreasonably delays patent rights to which patent applicants are lawfully entitled. This is an abuse of the Director's discretion in implementing examination procedures. It is prohibited under the Administrative Procedure Act, 5 USC §706, by Constitutional Due Process and by the express terms of 35 USC §134(a).

Upon the filing of an appeal brief procedures before the USPTO become adversarial. The Applicant has a grievance against the Examiner. The essence of the grievance is that the Examiner's action is depriving the applicant of a property right for which the applicant has qualified under the patent statutes. Constitutional Due Process requires a substantively fair procedure for adjudicating the grievance before a neutral decision maker. This is the function of

the Board. However, when the adversary himself is allowed to prevent review, and at the same time to perpetuate the grievance by continuing to withhold the patent right, the review process becomes illusory. The current practice effectively puts into the Examiner's hands the ability to prevent review of his own action. This is violative of Constitutional Due Process.

To the extent that the Director's general responsibility for quality examination might occasionally necessitate a discretionary reopening of prosecution after an Appeal Brief has been filed, that discretion must be exercised with substantive protections that are in fact effective to assure that Examiner's rejections are not routinely shielded from review by the Board of Patent Appeals and Interferences and ultimately the courts. 35 USC 134(a) is a substantive statutory limit on the Director's discretion that is not satisfied by allowing reopening of prosecution merely with an SPE signature.

Much more rigorous policing of cases in which prosecution is reopened is required to protect applicants from the abuse of their rights under 35 USC §134(a), the APA and the US Constitution than routinely occurs under current practice. At the very least, a proper accommodation of the Director's discretion with the Applicant's rights under §134(a) would provide the following:

1. For *each* un-consented decision to reopen prosecution, the Examiner must articulate on the record why any new rejections were not made previously and why the rejection is not cumulative of issues previously dealt with, and the SPE must sign off on that statement.
2. A second reopening of prosecution the Office will require both the articulation in item 1 above and an express finding of "clear necessity" made by the group director with the basis for that finding stated on the record.

3. Director-level approval should be instituted for third or higher re-openings such as occurred in this case.
4. Statistics on un-consented reopenings should be published so that the true frequency is widely known.

As the supplemental request the Director is requested to implement these protections.

### **Conclusion**

Good cause has been provided for the Director to exercise supervisory authority in this case to prevent reopening of prosecution and to implement more restrictive policies across the board to protect applicant's rights to appeal to the Board of Patent Appeals and Interferences. Both remedies are requested.

Respectfully submitted,  
VIDAS, ARRETT & STEINKRAUS

Date: September 16, 2008

By: /Walter J. Steinkraus/  
Walter J. Steinkraus  
Registration No.: 29592

6640 Shady Oak Dr., Suite 400  
Eden Prairie, MN 55344-7834  
Telephone: (952) 563-3000  
Facsimile: (952) 563-3001

f:\wpwork\wjs\9919us01\_supervisory\_petition.doc